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In re Application of :  
MINAMIO et al. :  
Application No.: 09/380,312 :  
PCT No.: PCT/JP98/02544 :  
Int. Filing Date: 08 June 1998 :  
Priority Date: 27 June 1997 :  
Attorney Docket No.: JEL 30763PC :  
For: RESIN MOLDED TYPE SEMICONDUCTOR  
DEVICE AND AN A METHOD OF  
MANUFACTURING THE SAME

DECISION ON PETITION

This is in response to applicant's "Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181 Based on Failure to Receive Office Action or in the Alternative Petition Under 37 CFR 1.137(b)" filed 21 September 2000 requesting that the United States Patent and Trademark Office withdraw the abandonment of the above captioned application, or in the alternative revive the application.

**BACKGROUND**

On 08 June 1998, applicant filed international application No. PCT/JP98/02544 which claimed a priority date of 27 June 1997, and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 07 January 1999. A Demand, electing the U.S., was filed with the International Preliminary Examining Authority prior to the expiration of 19 months from the priority date. As a result, the deadline for entry into the national stage in the U.S. expired 30 months from the priority date, on 27 December 1999.

On 31 August 1999, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia: the basic national fee; a translation of the international application; and a copy of the international application.

On 15 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that oath or declaration executed by the inventor and the \$130.00 surcharge for filing after the thirty-month period were required. The notification set a ONE (1) MONTH period for response.

On 15 September 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT UNDER 35 U.S.C. 371 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 15 February 2000 within the time period set therein.

On 21 September 2000, applicant filed the present "Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181 Based on Failure to Receive Office Action or in the Alternative Petition Under 37 CFR 1.137(b)" accompanied by: an executed declaration; Declaration of Docket Clerk; and a docket record for application no 09/380,312.

### **DISCUSSION**

#### **Petition Under 37 CFR 1.181**

With regards to applicant's request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement). Applicant has satisfied Items (1) and (2).

As to Item (3), applicants have provided a copy of the docket record which purportedly shows where the paper would have been entered had it been received. The printout of the docket report for this specific application is not sufficient to establish that the Notification of Missing Requirements was not received and mis-docketed for another application. Accordingly, applicant is required to provide docket record for 25 April 2000, indicating all applications for which a response was due on said date.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

#### **Petition to Revive Under 37 CFR 1.137(b)**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the submission of the declaration.

As to Item (2), the appropriate petition fee of \$1210.00 as required by 37 CFR 1.17(m) has been charged to Deposit Account No. 19-4375.

With regard to Item (3), applicant's statement that "entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and

1.137(b) for revival have been satisfied and revival is therefore appropriate.

Deposit Account No.19-4375 has been charged a \$130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date, as authorized.

**CONCLUSION**

For the reasons above, the petition to withdraw the holding of abandonment under 37 CFR 1.181 is **DISMISSED**.

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The application has an international filing date of 08 June 1998 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **21 September 2000**.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.



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